

REMARKS

Claim Amendments

In claim 1, the definitions of R¹¹ and R¹² are amended, for which support can be found, for example in original claim 2. In addition claim 1 recites the presence of a compound of formula IIA, which was formerly recited in original claim 5. Support for these amendments can also be found, for example, in example 1 of the specification.

The Rejections

Claims 1, 3-9 and 12-16 were rejected as allegedly anticipated by Kato US '820.

The composition of Example 1, which was the allegedly anticipating composition of the reference, does not contain a compound of formula IIA. Thus, there is no anticipation.

Claims 1-9 and 12-16 were rejected as allegedly anticipated by or obvious over DE '647.

The Office Action alleges anticipation, but admits that compounds of claim 2, which are now compounds of formula I of claim 1, are not in the examples, but are merely disclosed on page 14. The Office Action thereafter merely alleges that if claim 2 is not anticipated, it would have been obvious to substitute compounds of claim 2, which have two alkenyl groups at both terminal ends for compounds of formula I with one alkenyl group. However, beside the reference identifying such compounds on page 14 (and also on page 15), there is no reason provided for why one of ordinary skill in the art would be motivated to do so.

As the Examiner knows, for anticipation, and as a matter of fact even for obviousness, there has to be more than a mere broad generic disclosure in a reference, e.g., the listing of compounds with two alkenyl groups.

The Federal Circuit phrased the test for anticipation as follows:

to anticipate, **every element** and limitation of the claimed invention **must be** found in a single prior art reference, **arranged as in the claim**.
(Emphasis added.)

See *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 58 USPQ2d 1286 (Fed. Cir. 2001). The reference does not teach the claimed composition, i.e., the compounds disclosed by the reference are not brought together (i.e., "arranged") into a composition as claimed in the present application; and thus, this reference cannot anticipate under the test for anticipation.

Additionally, there is also no obviousness in the present case. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992) is despositive on this issue. In *Jones*, a certain salt comprised a cation and an anion. It was known in the field that the heterocyclic anion was the basis for the herbicidal activity of the salt. It was further known that the cation could be any quaternary ammonium cation. All would work because only the anion was the basis for the activity. Nevertheless, although the particular cation in the salt claimed was conventional, there was still no obviousness because nothing in the prior art suggested that, among all the known operable cations, the particular one at issue should be selected. Similarly here, even if it is alleged that the reference teaches various compounds with two alkenyl groups, and even if one of ordinary skill in the art would know that these compounds can be used in liquid crystal mixtures, more is needed to provide sufficient motivation to make the specific combination of the present claims obvious. But there is nothing of record about motivation in the reference for the combination of the various compounds recited in the present claims. The Office Action merely points to the compounds on page 14. Thus, the rejection should be withdrawn.

Reconsideration is respectfully requested.

Claim 10 is rejected as allegedly obvious over Kato or DE '647. The allegation is with regard to the use of the claimed composition in TN or STN displays. However, because the claimed compositions are not anticipated or obvious over these references, their use in TN or STN displays is not obvious either.

Claim 11 is rejected over Kato or DE'647 in view of US '792. The allegation is with regard to the use of the claimed composition in, e.g., SSCT or PSCT displays. However, because the claimed compositions are not anticipated or obvious over these references, their use in SSCT or PSCT displays is not obvious either.

Claims 1, 3-5, 9 and 12-16 are rejected as allegedly obvious over Heckmeier US '002.

Example M3 is pointed out by the Office Action as the reason for the rejection. This example does not contain either a compound of formula I or of formula IIA as claimed in the present claims.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Filed: October 24, 2006

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